

**REMARKS/ARGUMENTS**

Claims 1, 3, 7, 11 and 13-24 are present in this application. By this Amendment, claims 19 and 20 have been amended, and claims 21-24 have been added.

Reconsideration in view of the above amendments and the following remarks is respectfully requested.

At the outset, Applicants respectfully submit that the finality of the November 18, 2003 Office Action is premature and should be withdrawn. On page 5 of the Office Action, the Office Action contends that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." To the contrary, however, none of the rejected claims was amended in the September 8, 2003 Amendment. As a consequence of making the present Office Action a "final" Office Action, Applicants are denied a fair opportunity to prosecute their application before the Patent Office. That is, since no amendments to the claims were made in the September 8 Amendment, Applicants' remarks convinced the Examiner that the prior rejections were misplaced. Thus, even based upon the Examiner's understanding of the application and previous Office Action, Applicants have not been given a fair opportunity to reply. MPEP §706.07(a) provides that "second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement . . .*" For at least this reason, Applicants submit that the finality of the November 18 Office Action should be withdrawn.

Additionally, in paragraph 1 of the Office Action, the Examiner acknowledges an error in the previous Office Action. Thus, according to the Examiner, the November 18 Office Action is the first properly constructed calculation regarding a coefficient of water absorption. Without conceding that the calculation is correct, the Examiner's correction of an error in the previous Office Action provides further grounds that this Office Action should not have been made final.

**Withdrawal of the finality of the November 18, 2003 Office Action is thus respectfully requested.**

Claims 1, 3, 7, 11 and 13-18 were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,032,622 to Herrington et al. in view of U.S. Patent No. 6,237,717 to Osanai et al. This rejection is respectfully traversed.

Applicants submit that neither Herrington nor Osanai even remotely provides motivation to combine the references as asserted in the Office Action. Herrington discloses a shape memory foam member, primarily for the purpose of compressing the foam member for shipping. Herrington lacks any discussion of soundproof characteristics or function of its materials and in fact does not endeavor to provide such function. Osanai on the other hand discloses a soundproof member primarily suited for use in an automotive vehicle. Osanai lacks any appreciation of and is in fact not concerned with shape memory characteristics of its materials. Applicants submit that the divergent purposes and constructions of the materials in Herrington and Osanai and their use would not lead an artisan viewing one to look at the other to modify material

characteristics to achieve either purpose disclosed in the respective patents. In this context, the Federal Circuit has held that “the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). In this context, it is apparent that neither reference even remotely suggests the desirability of the modification proposed in the Office Action. See also *Northern Telecomm, Inc. v. Datapointe Corp.*, 908 F.2d 931 (Fed. Cir. 1990) (“[I]t is insufficient that prior art shows similar components, unless it also contains some teaching, suggestion, or incentive for arriving at the claimed structure”).

For at least these reasons, Applicants respectfully submit that there is insufficient motivation to combine Herrington and Osanai, and as a consequence, Applicants submit that the rejection is misplaced. Reconsideration and withdrawal of the rejection are respectfully requested.

Applicants acknowledge with appreciation the indication of allowable subject matter in claims 19 and 20. By this Amendment, claims 19 and 20 have been rewritten in independent form. Additionally, with reference to the Examiner’s suggestion in paragraph 2 of the Office Action, claims 21 and 22 have been added substantially corresponding to independent claims 1 and 11, but with the lower limit of the coefficient of water absorption being  $0.02 \text{ g/cm}^3$ . Support for this subject matter can be found in the specification at, for example, page 10, lines 13-22. New claims 23 and 24 have also been added, reciting that the coefficient of water absorption is in the range between

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0.056 g/cm<sup>3</sup> and 0.082 g/cm<sup>3</sup> in the non-compressed state. Support for this subject matter can be found in the specification at, for example, page 34, Table 1.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:   
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Alan M. Kagen  
Reg. No. 36,178

AMK:jl  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100